

Shaygan KHERADPIR et al.  
Applic. No. 10/083,822  
Docket No. 01-1004

### **REMARKS**

In the Office Action mailed April 20, 2004, the Examiner rejected claims 1, 5, and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter which applicant regards as the invention; rejected claims 1-16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,564,261 to Gudjonsson et al. ("Gudjonsson"); rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Gudjonsson in view of U.S. Patent No. 6,584,122 to Matthews et al. ("Matthews").

By this Reply, Applicants have amended claims 1, 3, 4, 5, 7, 8, 9, 11, 12, and 17, cancelled claim 13, and added new claims 18-31 to more particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. In light of the amendments and following remarks, Applicants respectfully request timely reconsideration and allowance of the present application.

The Examiner rejected claims 1, 5, and 17 under 35 U.S.C. § 112, second paragraph, asserting that the claims were indefinite because of the use of the terms "configure" and "configuration" in connection with different aspects of the recited invention. To advance prosecution, Applicants have amended these claims to clarify that the received message or call involves a request to configure a communication device, one or more rules is/are set based on information in the message or call, and a notification is transmitted to the user indicating the configuration of the communication device. However, these amendments were not required as the claims, prior to amendments herein, fully satisfy the requirements of 35 U.S.C. § 112, second paragraph.

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Applicants respectfully traverse the rejections of claims 1-16 as being unpatentable under 35 U.S.C. § 102(e), because the cited reference does not teach each and every element of the claimed invention, either expressly or under principles of inherency, as required by 35 U.S.C. §102(e). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the claim." M.P.E.P. § 2131 (8<sup>th</sup> Ed. 2001), *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8<sup>th</sup> Ed. 2001). Applicants submit these requirements have not been met for at least the following reasons.

Independent claims 1, 5, and 9 recite a combination including, among other things, "receiving a message from a user containing at least a request to configure at least one of the communication devices." Gudjonsson does not teach this feature. Gudjonsson, instead, discloses a "system/network [that] act[s] as a broker(s), and can broker communication service between two or more people . . . ." See Col. 7, lines 53-54. The network brokers communication by allowing a user to send an invitation, which "is basically a request from one user 7 to another to join him/ her in some given type of communication." See Col. 9, lines 8-10. While Gudjonsson provides a "routing service, that allows users to send requests (i.e. invitations) for communications sessions to other users, as well as configure how these invitations are handled depending on the user's current presence information," it does not disclose "receiving . . . a request to configure at least one of the communication devices," because a request to initiate a "communications session," as recited by Gudjonsson, is not equivalent to a request to "configure devices," as recited in claims 1, 5, and 9.

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Additionally, independent claims 1, 5, and 9 recite, among other things, "setting one or more rules for responding to a communication attempt to the at least one communication device based on information in the message," which Gudjonsson does not teach. Rather, Gudjonsson discloses:

[t]he requests are not sent directly between users. Instead, the routing service for the sending/inviting user sends the invitation to the routing service for the receiving user. The routing service for the receiving user determines, according to a logic specified by the same receiving user, how the request is handled and what services are available to handle the request.

See Col. 3, lines 17-22. Additionally, the logic specified by the user, as illustrated by Figure 26, is "preferably configurable from [an] admin tool, which has a connection to each back-end component . . . ." See Col. 32, lines 51-54. Thus, Gudjonsson only describes the use of a stand alone "admin tool" to "create new profiles, delete profiles, edit profiles." See Col. 32, lines 49-62. However, configuring a user profile via an "admin tool," as recited by Gudjonsson, is not the same as "setting one or more rules" via information in a "message," as recited in claims 1, 5, and 9. Therefore, Gudjonsson fails to disclose the use of a message to set "one or more rules for responding to a communication attempt to the at least one communication device."

Independent claims 1, 5, and 9 also recite, among other things, "transmitting to the user, through a real-time communication channel that is established by the instant messaging service, a notification indicating the configuration for the at least one communication device," which Gudjonsson also fails to teach. While Gudjonsson teaches the use of text chat invitations to "establish a real-time text chat session between users," it does not disclose "transmitting to the user . . . a notification indicating

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the configuration of the at least one communication device." See Col. 13, lines 12-13. Accordingly, a text chat invitation that establishes a real-time chat session is not equivalent to a notification indicating the configuration of a device, as recited in claims 1, 5, and 9.

For at least the foregoing reasons, Gudjonsson does not teach each and every element of the claimed invention. Applicants, therefore, respectfully request allowance of independent claims 1, 5, and 9, and by virtue of their dependence from these independent claims, dependant claims 2, 3, 4, 6, 7, 8, 10, 11, 12, 14, 15, and 16.

The rejection of claim 17 as unpatentable under 35 U.S.C. § 103(a) is respectfully traversed, since the Examiner has not made a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three requirements must be met. First, the reference or references, taken alone or in combination, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." See M.P.E.P. § 2143 (8<sup>th</sup> Ed. 2001). Applicants submit that these requirements have not been met for at least the following reasons.

First, Applicants submit that the Examiner has failed to set forth a *prima facie* case of obviousness, because the Examiner has failed to allege any suggestion for combining Gudjonsson with the speech processor of Matthews. In the Office Action, the

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Examiner stated that "[i]t would have been obvious to one skilled at the time the invention was made to modify Gudjonsson et al to have the 'receiving a . . . speech processor' as taught by Matthews et al such that the modified system of Gudjonsson et al would be able to support the speech processor to the system users." See O.A. at p. 5. Additionally, in response to the Applicants' response filed on January 30, 2004, the Examiner stated "[t]he motivation was to modify Gudjonsson et al so that the system of Gudjonsson et al would include limitation of 'receiving a . . . speech processor' as taught by Matthews et al." Applicants respectfully disagree.

To establish the *prima facie* case, there must be some suggestion or motivation in Gudjonsson and Matthews or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. No such suggestion or motivation exists. First, Gudjonsson possesses no need to look towards Matthews because Gudjonsson does not suggest the need for a speech processor. In fact, Gudjonsson fails to teach or suggest dynamically modifying client communication rules or profiles directly from client communication devices. On the contrary, Gudjonsson teaches the use of a stand alone "admin tool" to "create new profiles, delete profiles, edit profiles." See Col. 32, lines 49-62. Since the network does not support dynamic client interaction, Gudjonsson fails to suggest the need for rule or profile modification via voice commands or any other type of user commands. Similarly, Matthews contains no suggestion or motivation to combine its speech processor with the Gudjonsson system.

Consequently, neither Gudjonsson nor Matthews contain suggestions or motivation to combine in a manner resulting in the claimed invention. Moreover, the

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Examiner's stated motivation to combine reflects hindsight based on the Applicants' disclosure, which, among other things, explicitly provides a solution for allowing dynamic client interaction utilizing client communication devices. Accordingly, Applicants submit the *prima facie* case for obviousness had not been satisfied.

Further, Gudjonsson and Matthews, whether taken alone or in combination, fail to teach or suggest each and every element recited in the claims. For example, independent claim 17 recites, among other things, "setting one or more rules for responding to a communication attempt at the at least one communication device based on information in the call." As discussed above in connection with the rejection of claims 1-16 under 35 U.S.C. §102(e), Gudjonsson fails to disclose the use of "information in a call" to set "one or more rules for responding to a communication attempt at the at least one communication device," a limitation also found in claim 17. Furthermore, Matthews also fails to teach or suggest such a limitation. Accordingly, no combination of Gudjonsson and Matthews can render claim 17 obvious, and Applicants therefore request its timely allowance.

In view of the foregoing amendments and remarks, Applicants submit that the claimed inventions are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants, therefore, respectfully request reconsideration and reexamination of this application and the timely allowance of pending claims 1-31.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2347.

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Respectfully submitted,

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